

Atty. Dkt. No. 035451-0185 (3731.Palm)

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 1-15 and 17-29 are now pending in this application.

In Section 4 of the Office Action the Examiner rejected Claims 1-15 and 17-29 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,590,547 to Moriconi.

Claims 1, 15, 22, and 26

To establish a prima facie case of obviousness based on a combination of a prior art reference under 35 U.S.C. § 103(a) and knowledge of one of ordinary skill in the art, the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 USPQ 2d 1788 (Bd. Pat. App. & Inter. 1986).

In this case, the Examiner has not shown – and indeed, cannot show – that there would have been any motivation or suggestion to one of skill in the art to combine general knowledge with the teachings of Moriconi.

A brief description of the teachings of the cited references may be helpful for the following discussion. Moriconi relates generally to notebook and laptop computers that are

Atty. Dkt. No. 035451-0185 (3731.Palm)

customizable for a user by disengaging and selectively engaging a different display unit with the notebook or laptop computer.

Nevertheless, in the Office Action, the Examiner has alleged reasons why one of ordinary skill in the art would have been motivated to combine their knowledge with the teachings of Moriconi none of which appear to provide a proper motivation that may be relied upon in combining these references.

As noted in M.P.E.P. § 2143.01 (with emphasis added):

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art."

Applicants remark that the Moriconi patent is not applicable in that it discloses laptop and notebook computers, whereas what Applicants have claimed is a "handheld computing device" in independent claims 1, 15, 22 and 26. The recitation of a "handheld computing device" or "handheld computer" should be construed more narrowly than including a notebook or laptop computer as construed by the Examiner. Terms of the claims should be given their plain meaning. Here, Applicants are concerned with the construction of the words "handheld computer" by the Examiner. The Examiner has construed the notebook and laptop computer, which is disclosed in Moriconi as a handheld computer. Applicants, however, disagree.

Applicants submitted with a reply dated March 15, 2004 an Exhibit A which indicates that a "handheld computer" is "a computer small enough to be carried in your pocket." A laptop or notebook computer as disclosed in Moriconi, is not one which can conventionally be carried in your pocket. Applicants also submitted an Exhibit providing an alternative definition of the term "handheld" as it refers to computers. The Exhibit from the website SearchMobileComputing.com describes a handheld computer as "a computer that can

Atty. Dkt. No. 035451-0185 (3731.Palm)

conveniently be stored in a pocket (of sufficient size) and used while you are holding it.” Thus, it is clear that the plain meaning of “handheld computer” should not be construed to include laptop and notebook computers, as the Examiner has suggested. Further still, it should be appreciated that the Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the terms’ well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Accordingly, Applicantss refer the Examiner to the specification which states at paragraph [0003] “the size of the handheld computing device is generally compact and correspondingly, the visual display is smaller than the size of a standard computer monitor. The small size of the screen allows handheld computing devices to be portable, but less than ideal for viewing complex images of documents. The small size of the screen has necessitated that handheld computing devices focus on displaying abbreviated or simplistic content.”

In contrast, the laptop or notebook computer of Moriconi has a display which is relatively large and could easily be used for viewing complex images of documents, for example. Further, Applicants refer the Examiner to paragraph [0022] which states that a handheld computer can be “a handheld personal digital assistant (PDA), a wireless mobile phone, a pager, or any such device.” As is well known, all of these devices are approximately the size which could be conveniently carried in your pocket. Thus, it is clear that the Applicants have defined the term “handheld computer” within specified constraints which would not include the laptop and notebook computer of Moriconi. Laptop and notebook computers, such as those disclosed in Moriconi conventionally do not fit in a pocket. Thus, for these reasons, the Moriconi patent is not applicable.

The Examiner indicates that it would have been obvious to one of ordinary skill in the art to modify the notebook computer of Moriconi by altering its dimensional parameters. To this assertion, Applicants disagree.

As explained in Applicants’ reply of March 15, 2004, Applicants provided ample evidence of the definition of a “handheld computer” thereby differentiating it from a notebook or laptop computer. Further, Applicants respectfully submit that just because the laptop or

Atty. Dkt. No. 035451-0185 (3731.Palm)

notebook computer of Moriconi was a compact and highly ergonomic structure in 1992, when the original Moriconi application was filed, had different meaning to one of ordinary skill in the art than it did at the time of Applicants' filings in 2002. Further, just because Moriconi describes a compact and highly ergonomic structure, it does not describe a handheld computing device. The Laptop and notebook computers which are the only devices taught by Moriconi would have been seen as a compact and ergonomic structure, especially at the time in which the application was filed in 1992. Accordingly, there is no teaching or suggestion of a handheld computing device in Moriconi.

Further, the Examiner has indicated that where size and shape is of no importance, there is no difference between a laptop computer and a handheld computer. However, Applicants refer the Examiner to the Specification in which the advent of the handheld computer makes it important for the Applicants' invention. For example, the Applicants refer the Examiner to page 1 of the application to page 3 of the application, paragraphs [0003] to [0008]. In these paragraphs, the Applicants provide meaningful reasons for needing the claimed invention, including, but not limited to the fact that handheld computing devices were at the time of the invention, in transition and therefore it would have been beneficial to provide an interchangeable display unit. Further, and possibly more importantly, because the needs of different users of the handheld computing unit may be vastly different due to its extremely small size and extreme portability, there may be a need to interchange displays for a single user or for different users. Therefore, there is a significant reason for Applicants to provide interchangeable display modules for a handheld computing device. As such, Applicants have claimed in Claims 1-15 and 17-29, a handheld computing device and therefore the teachings of Moriconi are not applicable. Based on this alone, Applicants respectfully submit that Claims 1-15 and 17-29 are allowable.

Because the Examiner has not shown that the purported motivation to combine the teachings of Moriconi has come from the reference itself or from knowledge generally available to one of ordinary skill in the art because the reference does not teach or suggest handheld computing devices, the Examiner has not provided a proper case of obviousness.

Atty. Dkt. No. 035451-0185 (3731.Palm)

The Examiner's alleged motivation is thus similar to reasoning which was held to be insufficient to support a motivation to combine teachings of cited references by the U.S. Court of Appeals for the Federal Circuit. In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). In that case, the Board stated that the "conclusion of obviousness may be made from common knowledge and common sense of a person or ordinary skill in the art without any specific hint or suggestion in a particular reference." The Federal Circuit rejected this logic, stating that "neither the examiner nor the Board adequately supported the selection and combination of the . . . references to render obvious that which Lee described."

Without a proper motivation to combine the teachings of Moriconi and knowledge of one of ordinary skill in the art, it is apparent that hindsight reasoning has been used that relies on the Applicant's own disclosure as a roadmap.

Accordingly, the Applicant respectfully requests reversal of the rejection of Claims 1-15 and 17-29.

Claims 4, 5, and 23

Even if the teachings of one of ordinary skill in the art and Moriconi could be properly combined, Claims 4, 5, and 23 still would not have been obvious to one of ordinary skill in the art at the time of the invention. The Examiner's rejection of Claims 4, 5, and 23 under 35 U.S.C. § 103(a) over Moriconi should be reversed because at least one limitation of each of these claims is not taught or suggested by the reference.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (see M.P.E.P. § 2143.03). Because at least one limitation of each of independent Claims 4, 5, and 23 is not taught or suggested by the combination of one of ordinary skill in the art and Moriconi, these claims (and their associated dependent claims) would not have been obvious to one of ordinary skill in the art at the time of the invention.

Atty. Dkt. No. 035451-0185 (3731.Palm)

With regard to Claims 4, 5, and 23, Moriconi does not disclose, teach, or suggest a flexible, expandable, or foldable display. The need for a flexible, expandable, or foldable display is a unique need for a handheld computing device. In fact, the teachings of Moriconi of a laptop or notebook computer, provide no advantage for a expandable, flexible, or foldable display, because the laptop or notebook computer of Moriconi is already a large enough size for a typical user and therefore an expandable or foldable display is not required. Moriconi, as the Examiner indicated, teaches the use of a variety of displays, but Marconi never contemplated a flexible and expandable display as recited in Applicants' claims because a larger display was not needed by users of the laptop or notebook computers of Moriconi. Because Moriconi does not disclose, teach, or suggest a flexible, expandable, or foldable display, Applicants respectfully submit that the rejection of Claims 4, 5, and 23 should be withdrawn.

The rejection of Claims 4, 5 and 23 should be reversed, because at least one element of each of these claims is not taught or suggested by the combination of knowledge of one of ordinary skill in the art and Moriconi.

Accordingly, the Applicants respectfully request reversal of the rejection of Claims 4, 5, and 23.

Claims 2, 20, and 21

The Examiner has rejected Claims 2, 20, and 21 under 35 U.S.C. § 103(a). The Examiner's rejection of Claims 2, 20, and 21 under 35 U.S.C. § 103(a) over knowledge of one of ordinary skill in the art in view of Moriconi should be reversed because at least one limitation of each of these claims is not taught or suggested by the combination.

Applicants respectfully submit that Moriconi does not teach the use of wireless connections for the display device. See, e.g., pages 6-7, paragraph [0026]. Applicants contemplate that the display device may be used not only while attached to the handheld computing device, but also while being separated from the handheld computing device. What is taught in Moriconi is that the display is coupled to and supported by the housing of the laptop or

Atty. Dkt. No. 035451-0185 (3731.Palm)

notebook computer and therefore there is no need for a wireless connection. Thus, Moriconi never contemplated a wireless connection between the display unit and the laptop or notebook computer main unit because Moriconi did not foresee a need for a wireless connection. Applicants however, contemplate, as stated above that there may exist a wireless connection between the handheld computing device providing advantages which were not contemplated by Moriconi. Accordingly, Applicants respectfully submit that the rejection of Claims 2, 20, and 21 should be withdrawn

The rejection of Claims 2, 20, and 21 should be reversed, because at least one element of Claims 2, 20, and 21 are not taught or suggested by the combination of knowledge of one of ordinary skill in the art and Moriconi. Accordingly, the Applicants respectfully request reversal of the rejection of Claims 2, 20, and 21.

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Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Atty. Dkt. No. 035451-0185 (3731.Palm)

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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